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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/029,913 | 12/31/2001 | Ulf Landegren | LAND DIV | 5983 |
| 466 7590 04/02/2007 YOUNG & THOMPSON 745 SOUTH 23RD STREET 2ND FLOOR ARLINGTON, VA 22202 | | | EXAMINER FORMAN, BETTY J | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1634 | |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | MAIL DATE | DELIVERY MODE | |
| 3 MONTHS | | 04/02/2007 | PAPER | |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/029,913

Applicant(s)

LANDEGREN, ULF

Examiner

BJ Forman

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1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34,35,38-44 and 46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34,35,38-44 and 46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. <u>23 March 2007</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

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DETAILED ACTION

Status of the Claims

This action is in response to papers filed 8 March 2007 in which claims 38-42 and 46 were amended. The amendments have been thoroughly reviewed and entered. The previous rejections in the Office Action dated 26 May 2006 are withdrawn in view of the amendments and Terminal Disclaimer filed 29 January 2007.

New grounds for rejection are discussed.

Claims 34-35, 38-44 and 46 are under prosecution.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 34-35, 38-44 and 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 38 and 39 are each indefinite for the recitation "said target-specific probe" because "target specific" lacks proper antecedent basis in Claim 44. It is suggested the claims be amended to provide proper antecedent basis e.g. delete "target specific".

Claim 38 is further indefinite for the recitation "the hybridized probes are covalently interconnected" because the preceding text of the claim does not define "hybridized probes". It is suggested the claim be amended to clarify e.g. replace the recitation with "said additional probe is covalently connected to the ends of the hybridized probes of step c).

Claim 39 is further indefinite for the recitations "or probes" and "or gaps" because the recitation lacks proper antecedent basis in the single probe of Claim 44. It is suggested that Claim 39 or 44 be amended to provide proper antecedent basis

Claim 39 is further indefinite in line 4 for the recitation "covalently interconnecting"

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because the recitation lacks proper antecedent basis in the "covalently connecting" of Claim 44.

It is suggested the claims be amended to provide proper antecedent basis e.g. replace "interconnecting" with "connecting".

Claim 40 is indefinite in line 4 for the recitation "said covalent connecting" because the recitation lacks proper antecedent basis in the "covalently connecting" of Claim 44. It is suggested the claims be amended to provide proper antecedent basis e.g. replace "covalent" with "covalently".

Claims 34-35, 38-44 and 46 are indefinite in independent Claims 4, 44 and 46 for the repeated use of the recitation "said immobilized probe". The recitation lacks proper antecedent basis in step a). It is suggested the claim be amended to clearly provide proper antecedent basis throughout the claim e.g. in step a) recite "providing an immobilized oligonucleotide probe" or replace the phrase "said immobilized probe" with "the immobilized probe".

Claims 34-35, 38-44 and 46 are indefinite in independent Claims 4, 44 and 46 for the recitations "said other end part" (step a), line 5); "said dissociable probe part" (step d), line 1); "said dissociation" (step d), lines 6 and 12); and "the remaining" (step f), line 2). It is suggested the claim be amended to provide proper antecedent basis e.g. replace "said other end part" with "the other end part" (step a), line 5); replace "said dissociable probe part" with "said dissociable part" (step d), line 1); replace "said dissociation" with "said dissociating" (step d), lines 6 and 12); and replace "the remaining" with "the covalently connected" (step f), line 2).

Claims 34-35, 38-44 and 46 are indefinite in independent Claims 4, 44 and 46 for the recitation "wherein said probe comprises two padlock probes and said dissociable part is a second circular padlock probe hybridization to said target-specific probe". The recitation is indefinite because "second circular" lacks proper antecedent basis because it is not preceded by a "first" and "target-specific" lacks proper antecedent basis in the claim.

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It is suggested the claim be amended to clarify e.g. "wherein said probe comprises two circular padlock probes and said dissociable part is ~~a second~~ one of said circular padlock probe hybridization to said ~~target-specific~~ probe".

Claims 34-35, 38-44 and 46 are indefinite in independent Claims 4, 44 and 46 because the claims are drawn to a method of detecting a target sequence. However, the method steps do not include a step for detecting a target. Therefore it is unclear whether the method steps accomplish the stated objective. It is suggested a step of target detection be added to clarify the invention e.g. in step f), after "detecting" insert "the target nucleic acid sequence by detecting".

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BJ Forman whose telephone number is (571) 272-0741. The examiner can normally be reached on 6:00 TO 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla can be reached on (571) 272-0735. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

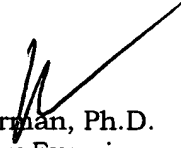
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

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For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.



BJ Forman, Ph.D.
Primary Examiner
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March 29, 2007